

REMARKS

In the Final Office Action dated Nov. 17, 2005, Claims 1, 3-6, 14-17 and 21 were rejected under §112 as lacking support in the specification. Prior claims 7-12 and 18-20 were withdrawn pursuant to a restriction requirement imposed years after examination began. New dependent Claims 22-49 are withdrawn pursuant to a newly imposed restriction requirement.

Interview

Applicant thanks the Examiner and her supervisor for the courteous telephone interview held January 24, 2006, during which the undersigned directed the Examiner's attention to paragraphs 27 45, 49 and 55 regarding the history, and directed the Examiner's attention to paragraph 27 on the flat package containing audiovisual discs. These paragraphs were discussed and seemed to resolve the Section 112 concerns, but the Examiner wanted to review them further after the interview and making any commitment.

In a follow up call the Applicant was asked to make responsive arguments in writing to make the record clear. The response is as follows:

Section 112 Rejection – "History"

The specification defines a barcode placed on an item where the barcode contains information on the customer. Independent Claim 1 was amended to further define the return "history" to include information on returns in addition to the current purchase.

the bar code includes an order and return history of prior purchases and returns for that customer **other than the item mailed**.

That the bar code contains information on prior purchases and returns other than or in addition to the current one, is found at the following paragraphs of the application as published by the Patent Office: Paragraph 45 ("repeat customers ... the merchant keeps track of the items that the customers orders."); 49 ("scanning the bar code 42 on the package 10 may call up a list of all items that the customer has previously ordered"); 55 ("repeat customer"); 57 (merchant personally reviews prior purchases to decide what promotional advertisements to include with the current purchase). Further, the meaning of "history" also includes past events in addition to the current action.

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One skilled in the art would recognize that the applicant had possession of the claimed combination which refers to prior purchases or returns.

Claims 1, 3, 4, 14-16 and 21 are believed allowable, and such allowance is respectfully requested.

Withdrawn claims 38-48 depend from Claim 1 and are believed allowable.

Section 112 Rejection – “Flat Disk With Audio/Audiovisual Information”

Claim 5 was found to lack support for “a merchant providing a package containing a flat disk having recorded thereon audio or audiovisual information for mailing a product sold to the customer.” Office Action at 3.

Support is found in the application published by the Patent Office at paragraph nos. 4 (“adapted for mailing one or more flat items 11, such as compact discs (CD’s) and digital versatile discs (DVD’s).”); 51 (“a DVD exchange program”), 53-54 (DVD’s).

One skilled in the art would recognize that the applicant had possession of the claimed subject matter. Claim 5 and dependent Claims 6, 17 and 49 are believed allowable.

Conclusion

In view of the above comments, reconsideration and withdrawal of the rejection of the identified claims is requested. Any withdrawn claims now allowable in view of the allowance of a generic claim, are also believed allowable.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Date: 1/24/06

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